



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/467,994	12/20/1999	BRUCE A. YOUNG	450.312US1	3101

24333 7590 11/25/2002

GATEWAY, INC.  
ATTN: SCOTT CHARLES RICHARDSON  
610 GATEWAY DRIVE  
MAIL DROP Y-04  
N. SIOUX CITY, SD 57049

EXAMINER

GREENE, DANIEL L

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 11/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/467,994	<b>Applicant(s)</b> YOUNG, BRUCE A.	
	<b>Examiner</b> Daniel L. Greene	<b>Art Unit</b> 3621	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 October 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 14-16 and 23-27 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-22, 28 and 29 is/are allowed.
- 6) ☒ Claim(s) 1-13, 17, 18 and 30-32 is/are rejected.
- 7) ☒ Claim(s) 33, 34 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
     If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
     a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s). <u>9</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)              |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other:   |

## Interview Summary

Application No.

09/467,994

Applicant(s)

YOUNG, BRUCE A.

Examiner

Daniel L. Greene

Art Unit

3621

All participants (applicant, applicant's representative, PTO personnel):

(1) Daniel L. Greene. (3) \_\_\_\_\_.

(2) Scott C. Richardson. (4) \_\_\_\_\_.

Date of Interview: 22 October 2002.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: \_\_\_\_\_.

Identification of prior art discussed: \_\_\_\_\_.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: The Examiner contacted Mr Richardson in reference to a notice sent to him of an incomplete document. The document in question was a fax that arrived in two parts detailing out his admendments. The Examiner upon reviewing the two documents found them together to be complete and is proceeding ahead with the examination.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☐ It is not necessary for applicant to provide a separate record of the substance of the interview(if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

  
Examiner's signature, if required

## **DETAILED ACTION**

### **Status of Claims**

Applicant has canceled claims 14-16 and 23-27. Claims 33-34 have been added. Therefore, Claims 1-13, 17-22 and 28-34 are now pending in the application.

### ***Response to Amendment***

1. The declaration under 37 CFR 1.132 filed 10/07/02 is insufficient to overcome the rejection of claims 1-13, 17-18, and 30-32 based upon prior art as set forth in the last Office action because the Applicant's arguments filed 07 October 2002 have been fully considered and found not to be persuasive.

### ***Allowable Subject Matter***

As per claims 19-22, and 28-29, the closest prior art of record 5,839,058 taken either individually or in combination with other prior art of record fails to teach or suggest providing a label comprising an address of the return center and having an amount of postage sufficient for the third-party delivery service to return the product to the return center and the said label is configured for being attached to the return mailer upon returning the product to the return center or alternatively for being attached to another return mailer if the product is not returned to the return center.

The specific allowable feature, which distinguishes the present invention over the prior art is providing a label comprising an address of the return center and having an amount of postage sufficient for the third-party delivery service to return the product to the return center and the said label is configured for being attached to the return mailer

upon returning the product to the return center or alternatively for being attached to another return mailer if the product is not returned to the return center.

The unique feature not taught or suggested is a label that can be applied to different pieces of mail that has prepaid postage and an address on it ready for use.

Claims 20-22 are dependent upon claim 19, claims 28-29 are dependent on claim 20, which is dependent on claim 19, and thus have all the limitations of claim 19 and are allowable for that reason.

### ***Claim Objections***

Claims 33 and 34 are objected to because they are dependent on a rejected claim. However, they would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

2. The Applicant pointed out that the rejection of claim 10 does not lend itself to the inherency type rejection. The Examiner agrees. However, as pointed out by the Applicant, the correct rejection is one of the obvious types. As per the Applicant, " ... there are a number of types of identifiers suitable for use on return mailers (e.g., an identifier is commonly provided in the form of a printed alphanumeric character,) Since the overall rejection of the application is based on the 103-Obviousness type rejection, no new grounds for rejection have been introduced.

3. The Applicant submits that there is a misapplication of the 35 U.S.C. 103 rejections of claims 16,17,20,21,22,24,25 and 29. The Applicant supports his submittal

by stating, " ... stating that an element of each of these claims, " is only limited by the imagination of the designer and therefore non-limiting," This rejection is not in accordance with 35 U.S.C. 103...." The key part of the rejection is in the word element. As pointed out in the rejection, the modifier or a description to/of an item does not make that item unique. As per claim 16, the Applicant describes "product rental terms" to include specified return date and product condition. The Examiner contends that "product rental terms" is the limiting factor and defining what "product rental terms" could be is only limited by the imagination of the designer. Each of the following claims provide elements for each of the different claim limitations such as, Claim 17-database information, Claim 20-unique code, Claim 21-type or kind of data in the database, Claim 22-type or kind of contract liability, Claim 24- type or kind of additional data, Claim 25-content of transaction records, Claim 29-type or kind of credit. The art presented in the previous 103 rejections discloses the concepts of the aforementioned claim limitations and therefore stands as presented. The Examiner agrees that claims 16,17,20,21,24,25 and 29 are dependent claims, which derive antecedent basis from their respective parent claims and further define features of the parent claims from which they depend. Therefore, as per the aforementioned discussion, the claims are rejected.

4. The Applicant cites MPEP 2145; " it is improper to combine references where the references teach away from their combination." The Applicant specifically submits that, "... the Shah patent teaches away from returning an item to a location different than the location where it was dispensed." For a patent to teach away from an action/concept it must so stipulate. Shah makes no such statement. Shah discloses a return policy and

does not state that this policy negates any other type of return policy or is superior or unique to any other return policy. The Applicants argument does not direct the Examiner attention to where Shah specifically stipulates benefits of their return system. The Applicant does point out that Shah does elaborate on the benefit of the distribution of a product, versus returning, "... the present invention ... does not require a central distribution mode, ..." This reference is for the distribution and not the returning of a product and is not considered relevant.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Claim Rejections - 35 USC §  
103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

Art Unit: 3621

person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13,17-18 and 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah US 5,028,766 [Shah `766], Phillips- US 5,839,058 [Phillips `058] and Peters US 5,769,269 [Peters `269].

As per claim 1.

Shah `766 discloses a product dispensed from a vending machine in one location. Col.1, lines 42-44.

Shah `766 does not specifically disclose a product return system, comprising: a return mailer dispensed with the product, the product returnable in the return mailer to a return center, the return center in another location. However, Shah `766 does disclose a system that does require the customer to return a product dispensed from a vending machine. Col. 2, line 8.

Phillips `058 discloses a system that does require the customer to return a product after use. Col. 3, lines 7-12.

Phillips `058 further discloses a return mailer dispensed with the product for returning the product to a predetermined entity. Col. 12, line 51.

Phillips `058 does not specifically disclose a vending machine as providing the POS product. However it is well known and understood in the retail marketing industry POS marketing and distribution of products can be either is by vending machines or station clerks.



Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into the vending machine of Shah '766 the product of Phillips '058 to provide another POS outlet and increase the availability of the product to the public.

Phillips '058 does not specifically disclose a return center in another location. However, Phillips '058 does disclose returned by the user, ...by mail, to a predetermined entity. It is inherent in Phillips '058 that "predetermined entity" is another location other than the POS since the phone is being refurbished at the "predetermined entity". Also, "return " is not a limiting claim because it is a nonfunctional description. "A return center" could also be called a "predetermined entity" or a recycle center, etc., and not affect the method of returning an object to a place. Since this difference is only found in the nonfunctional descriptive material and does not alter how the item is returned, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404(Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to name a site for receiving returned goods anything they wanted because such data does not alter the limiting concept of utilizing a mailer and the subjective interpretation of the data does not patentably distinguish the claimed invention.

Shah '766 does not specifically disclose wherein a product rental fee is defined in a set of product rental terms, further wherein the product rental fee includes fees for

non-compliance with the product rental terms. Shah '766 does disclose a flow chart block designated rates and terms for the rental of allowables. Fig. 14A. Shah '766 further discloses refund upon returning the articles. Col. 6, lines 26-40.

The examiner interprets the refund upon returning the article to be the same as fees for non-compliance with the product rental terms and that is included in the initial cost along with the regular product rental fee.

Therefore, Shah '766 does teach about the product rental fee is defined in a set of product rental terms, further wherein the product rental fee includes fees for noncompliance with the product rental terms.

Shah 766 further discloses determining compliance or non-compliance with the product rental terms, further wherein an additional charge is posted to a consumer account or a future credit to a consumer account is canceled for non-compliance with the product rental terms. Col. 6, lines 15-40.

Shah '766 does not specifically disclose wherein the return center determines the action to be taken. However, the rental center can be a central office or a predetermined entity as identified in the prior art, which does determine the actions to be taken and requires no further explanation.

Shah '766 does not specifically disclose wherein product rental terms include terms related to a specified return date and product condition.

However, Shah '766 does disclose a flow chart block designated rates and terms for the rental of allowables.

The element of "product rental terms" is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms related to a specified return date and product condition). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See *on re Gulak* 217 USPQ 401 (CAFC 1983), *ex parte Carver*, 227 USPQ 465

(*BdPatApp&Int* 1985) and in *re Lowry*, 32 **USPQ2d 1031 (CAFC 1994)** where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of rental terms (i.e., a specified return date, product condition, early return, etc.) in their contract that they felt would benefit their company.

As per claim 2.

Shah '766 and Phillips '058 discloses the claimed invention except for a controller containing a database with information on the product, the controller connected to the vending machine and to the return center with transmission links.

Peters `269 teaches that it is known to have a controller containing a database with information on the product, the controller connected to the vending machine and to the return center with transmission links. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a controller containing a database with information on the product, the controller connected to the vending machine and to the return center with transmission links as taught by Peters `269, since Peters `269 states at Col.7, lines 1-43 that such a modification would enhance the ability of the company to track the use and disposition of their product to provide proper service/rebate to the customer.

Peters `269 does not specifically disclose a "return center". However Peters `269 does disclose a Customer Service Center (CSR). The examiner is taking Official Notice that a "return center and a Customer Service Center (CSR) can serve as the same function.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to substitute the "return center" for a CSR since both of them deal with products and customers remote of the POS site.

As per claim 3.

Shah `766 and Phillips `058 disclose the claimed invention except for the product is a media product selected from the group consisting of DVDs, CDs, videotapes, software media and audiotapes. Peters `269 teaches that it is known to have product that is a media product selected from the group consisting of DVDs, CDs, videotapes, software media and audiotapes.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to have product that is a media product selected from the group consisting of DVDs, CDs, videotapes, software media and audiotapes as taught by Peters `269, since Peters `269 states at Col.2, lines 49-56 that such a modification would increase the items available to the customer from the Shah`766 vending machine to increase the selection to the customer.

As per claim 4.

Shah `766 further discloses wherein the product is rented using a transaction card. Fig. 14A

As per claim 5.

Shah `766 and Phillips `058 discloses the claimed invention except for wherein the vending machine is located in a location selected from the groups consisting of an airport, a railroad station, a bus station, a subway, a store and a hotel.

Peters `269 teaches that it is known to place the vending machine in a location selected from the groups consisting of an airport, a railroad station, a bus station, a subway, a store and a hotel.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the vending machine in a location selected from the

groups consisting of an airport, a railroad station, a bus station, a subway, a store and a hotel as taught by Peters `269, since Peters `269 states at Col.1, lines 23-35 that such a modification would place more than one of the Shah `766 vending machine in different locations to increase coverage and revenue.

As per claim 6.

Shah `766 and Phillips `058 does not specifically disclose wherein the product is obtained in a first location, used in a second location and deposited in a collection box in a third location. However, Shah `766 does disclose where a product is obtained in a first location and used in a second location. Col.2, lines 5-8.

Phillips `058 discloses wherein the product is obtained in a first location, used in a second location and deposited in a collection box in a third location. Col. 3, lines 6-25. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah `766 system, Phillips `058 additional action of depositing in a collection box in a third location after the customer is done with the product to facilitate disposal.

As per claim 7.

Shah `766, Phillips `058 and Peters `269 discloses all the limitations of claim 2.

Shah `766 does not specifically disclose a service agent facility having an automated service agent, the automated service agent having means for accessing the database. However, Shah `766 does disclose a dailless phone 7, which may be connected to a central office or to a manager... Col.3, line25-26

Peters `269 discloses a service agent facility having an automated service agent, the automated service agent having means for accessing the database. Col. 7, lines 1-60.

The element of connecting to the central office or a manger is the equivalent of connecting to an automated service agent because both represent the company and both can serve the same function as the other.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah `766 system, Peters `269 automated service agent in place of Shah `766 central office or manager contact to facilitate another way to help a customer.

---

As per claim 8.

Shah `766, Phillips `058 and Peters `269 discloses all the limitations of claim 7.

Shah `766 does not specifically disclose comprising instructions issued by the controller to the return center and to the service agent facility, the instructions providing information on inventory management. However, Shah `766 does disclose a telephone modem 165 to receive information from a central office, remote manager.

Peters `269 discloses instructions issued by the controller to the return center and to the service agent facility, the instructions providing information on inventory management via a telephone modem. Col. 7, lines 1-60.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to utilize a telephone modem to convey information between different locations about the status of inventory to facilitate control over the inventory.

As per claim 9.

Shah `766, Phillips `058 and Peters `269 discloses all the limitations of claim 1.

Shah `766 does not specifically disclose a transaction identifier on the return mailer.

However, the examiner takes Official Notice that it would be obvious to a person of ordinary skill in the art to have on a return mailer some form of transaction identification.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to put a transaction identifier on the return mailer.

As per claim 10.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 9.



Shah '766 does not specifically disclose wherein the transaction identifier is a scan able code.

However, the examiner takes Official Notice that it would be obvious on return mailers that the identifiers are all scan able codes.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the identifiers as scan able codes to facilitate machine reading of the mail and, reduce the need for personnel to manually handle.

As per claim 11.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 10.

Shah '766 does not specifically disclose the return mailer has pre-paid postage and is pre-addressed to the return center. However, Shah '766 does disclose a storage cartridge with a data strip. Col. 4, lines 9-11

Phillips '058 discloses the return mailer that has data strips that are pre-paid postage and an address for the return center. Col. 6, lines 59-63.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah '766 data strip, Phillips '058 data representing pre-paid postage and the address of the return center to assist the ease of the customer to return the product.

As per claim 12.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 discloses the claimed invention except for wherein the cover around the product is a return mailer. Phillips '058 teaches that it is known to wherein the cover around the product is a return mailer. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover around the product a return mailer as taught by Phillips '058, since Phillips '058 states at Col.6, lines 48-67 that such a modification would provide for the convenience of the customer to return the product.

As per claim 13.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 1.

Shah '766 does not specifically disclose wherein the product is not returned to the return center.

However, wherein the product is not returned to the return center does not add further limitations to claim 1 and is not considered to be further limiting.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to not provide any action when a product is not returned to the return center.

Art Unit: 3621

As per claim 17.

Shah '766 does not specifically disclose wherein the database contains information selected from the group consisting of a transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price.

Shah '766 does disclose the use of databases by the central data center for interacting with each station. Col. 3, lines 52-54. Peters '269 discloses databases and the uses and contents thereof. Col. 5,6,7.

The element about the information contained in a database is only limited by the imagination of the designer and therefore non-limiting. PTO's guidelines for examining claimed language require: the examiner must make a determination, whether the claimed invention "as a whole" would have been obvious at the time of the invention to one of ordinary skill in the art. See MPEP 2142. In this pending claim, the examiner submits the particular language does not serve as a limitation for the claim (i.e., terms related to transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price.). A limitation on a claim can be broadly thought of as its ability to make a meaningful contribution to the definition of the invention in a claim. In other words, language that is not functionally interrelated with the useful acts, structure, or properties of the claimed invention will not serve as a limitation. See on re Gulak 217 USPQ 401 (CAFC 1983), ex parte Carver, 227 **USPQ** 465 (BdPatApp&Int 1985) and in re Lowry, 32 USPQ2d 1031 (CAFC 1994)

where language provided certain limitations because of specific relationships required by the claims.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include any type or kind of data (i.e., transaction identifier, product title, product dispense date, specified return date, product condition, product rental fee and product purchase price, etc.) in their databases that they felt the company would need to track and use to better control their business.

As per claim 18.

Shah '766, Phillips '058 and Peters '269 discloses all the limitations of claim 17.

Shah '766 does not specifically disclose wherein the return center determines compliance with the specified return date by noting the actual return date and comparing the actual return date with the specified return date in the database.

Shah '766 does disclose determining compliance or non-compliance with the product rental terms, further wherein an additional charge is posted to a consumer account or a future credit to a consumer account is canceled for non-compliance with the product rental terms. Col. 6, lines 15-40.

The element of describing that the non-compliance with the product rental terms includes determining whether or not the product was returned within the rental period specified is obvious. This can only be done by noting the actual return date and comparing the actual return date with the specified return date in the database. Shah

'766 does not specifically disclose wherein the return center determines the action to be taken.

However, as disclosed in previous claims the rental center can be a central office or a predetermined entity as identified in the prior art and requires no further explanation.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine compliance with the specified return date by noting the actual return date and comparing the actual return date with the specified return date in the database.

As per claim 30.

Shah '766 discloses;

means for selecting a particular product; Fig.1, **70**

means for dispensing the particular product Fig.1, **60**

means for identifying the particular product;

Fig.1, **27**

means for recording a transaction date in a

database; Fig. 3

wherein said particular product is a media product. Col.4, lines 9-35

Shah '766 discloses the claimed invention except for the means for transporting comprises a return mailer dispensed at said means for dispensing. Phillips '058 teaches

that it is known that a means for transporting comprises a return mailer dispensed at said means for dispensing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the means for transporting comprising a return mailer dispensed at said means for dispensing. as taught by Phillips '058, since Phillips '058 states at Col.6, lines 48-67 that such a modification would provide for the convenience of the customer to return the product.

As per claim 31.

Shah '766 further discloses wherein the means for selecting and depositing a particular product is a vending machine. Abstract.

As per claim 32.

Shah '766 further discloses a means for identifying the particular product; and means for recording a transaction date in a database. Fig. 1, **70**, Fig.3.

Shah '766 does not specifically disclose the means for identifying the product and rental date in a unique code, the unique code enterable in the database. However, Phillips '058 discloses the means for identifying the product and rental date with a unique code, the unique code enterable in the database. Fig.1, **55,57**. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate into Shah '766 means for identifying the particular product with Phillips '058 means for identifying the product and rental date with a unique code, the unique code enterable in the database.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rawlings-US 6,155,481 RETURNABLE MAILER

Joanne Tangorra-Publishers Weekly, v238, n48, p54(1), Nov.1, 1991-Audio

Rentals on the rise in Audio Stores

Laura Dempsey-Dayton Daily News (DA)-Friday March 29,1991- Edition: City

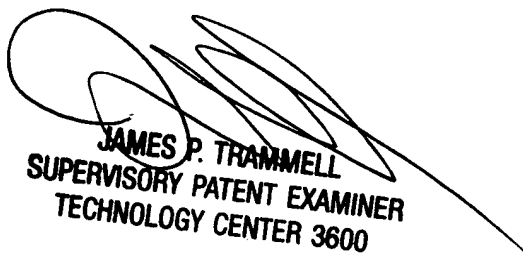
Section: GO! p16. STICK IT IN YOUR EARS WHILE LISTENING TO A GOOD BOOK.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel L. Greene whose telephone number is 703.306.5539. The examiner can normally be reached on M-Thurs. (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703.305.9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305-7687 for regular communications and 703.305.7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308-1113.

DLG  
November 7, 2002

  
JAMES P. TRAMMELL  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600